UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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			EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/940,767	LUND, ARNOLD M.
		Examiner	Art Unit
		Clara Yang	2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 April 2004</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7,9-13,15,17-19 and 21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7,9-13,15,17-19 and 21</u> is/are rejected.

7)☒ Claim(s) <u>4 and 12</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Arguments

1.   Applicant's arguments filed on 9 April 2004 with respect to claims 1 (see page 9, "Gorday does not teach or suggest storing a message in a communication mode agnostic format") have been considered but are moot in view of the new ground(s) of rejection.

2.   Applicant's arguments filed on 9 April 2004 have been fully considered but they are not persuasive.

On page 9, the applicant argues that Gorday fails to teach the activation of a message-waiting indicator associated with PSU. However, since the claim omits calling for a specific type of message-waiting indicator, it is understood that PSU 106's alert 322 and display 324 (see Fig. 3) form a message-waiting indicator since alert 322 is activated by the receipt of system controller 102's second message (see Col. 8, lines 26 – 29) and display 324 displays the second message (see Col. 11, lines 47 – 50), which indicates that a first message is being stored.

In response to applicant's argument on pages 10 and 11 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., stored information of a sender's communication mode is made available to and accessed by the "pagee") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 6, 10, and 18 all call for "storing information relating to a communication mode for the pagor that the pagee can use when returning the page". As noted by the applicant, though Gorday omits teaching that a sender's communication mode be made available to the recipient, system controller 102 notifies the sender that the recipient has responded to the page when system controller 102 receives the recipient's response. Consequently, the recipient indirectly uses the sender's communication

mode, which is stored and used by system controller 102 to notify the sender of the recipient's response, in order to respond to the page.

Regarding the argument on page 10 that Gorday omits teaching all of the recitations of claim 19, as explained above, Gorday's system controller 102 stores a sender's communication mode in order to send a notification to the sender that the recipient has responded to the page. As for the step of "automatically connecting the pagee to the pagor using the communication mode", the step omits specifying that the pagee be directly connected to the pagor. On page 8 of the specification, though the applicant teaches that UMS 112 provides direct telephone connection between the recipient and the sender when the recipient opts to use the telephone for returning the page, the other two options (fax and email) teaches that the recipient speaks a message into UMS 112, which converts the spoken message into a fax message or an email and then sends the converted message to the sender (see lines 19 – 30). Likewise, Gorday teaches that the recipient sends a response to the sender via PSU 106, and system controller 102 receives the response and generates another message that is sent to the sender (see Col. 6, lines 42 – 52). Gorday teaches that sender sends a voice page via telephone 101 or an alphanumeric page via facsimile machine 120 (see Fig. 1 and Col. 3, lines 50 – 65). Consequently, Gorday's system controller 102 automatically connects the recipient's PSU 106 to the sender's telephone 101/facsimile machine 120 by receiving a response from the recipient's PSU 106, generating a message (such as voice or facsimile message if the sender is using telephone 101 or facsimile machine 120 respectively) that indicates that a response to the page has been received from PSU 106, and sending the message to the sender (see Col. 6, lines 47 – 52). Furthermore, system controller 102 must retrieve the sender's stored communication mode in order to send the message to the sender.

On page 11, the applicant interprets that LaPorta's array of reply-to addresses "may include a list of all the addresses the message was originally sent to in order to facilitate a 'reply all.'" However, LaPorta clearly states in Col. 14, lines 46 – 48 that "the reply-to address is the address of the message originator". Because each subscriber 40 has a user agent for storing message filtering/forwarding criteria (see Fig .11; Col. 6, lines 18 – 22; and Col. 7, lines 18 – 30), a user agent must store at least one communication mode for subscriber 40. In LaPorta's example of a subscriber S 200 sending a message to recipients R1, R2, and R3, LaPorta teaches that R3's user agent informs messaging server 210 that R3's pager is off and that subscriber S 200's message should be forwarded to a message storage server (see Col. 15, lines 12 – 16). In light that a subscriber 40's user agent is able to forward messages as specified by the subscriber and that a subscriber can have a plurality of reply-to addresses, the examiner interprets that the user agent is able to store a plurality of communication modes for a subscriber. However, regardless of where a user's communication modes are stored, LaPorta does teach the step of storing a plurality of communication modes for the message originator.

Claim Objections

3.   Claims 4 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Both claims require the step of "activating the message-waiting indicator after a predetermined criterion is satisfied", which is already called for in claim 1 ("activating a message-waiting indicator associated with the pager after there is no response for the predetermined time period") and claim 10 ("activating a message-waiting indicator associated with the pager after the waiting step").

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No.

5,726,642 (Kudoh et al.).

Kudoh's method for sending a page to a pager, as shown in Fig. 5, comprises the steps

of: (a) a pager receiving a page wirelessly (see Col. 3, lines 16 – 21 and Col. 5, lines 61 – 65); (b)

decoder 3 converting the demodulated signal from radio portion 2 into a digital signal or

message (see Col. 3, lines 23 – 26); (c) control portion 5 determining that the recipient has not

responded to the message for a predetermined time period (see Steps 4 and 8 and Col. 6, lines

14 – 17 and 30 – 43); (d) control portion 5 storing the message in message memory 8 as a non-

read message (see Step 10); and (e) control portion 5 generating a non-read alarm or message-

waiting indicator (see Steps 1 and 2). The message is understood to be in a communication

mode agnostic format because it has been demodulated and decoded and thus is no longer a

specific communication mode format.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1 - 13, 15, 17 - 19, and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 5,703,570 (Gorday et al.) in view of U.S. Patent No. 5,974,300

(LaPorta et al.).

Regarding claims 1, 4, 6, 7, 10, 12, 15, and 18, Gorday teaches a method comprising the

steps of: (a) system controller 102 receiving a message intended for a portable subscriber unit

(PSU) 106 from a remote sender (i.e., "pagor") via telephone 101, facsimile machine 120, or

messaging terminal 122 (see Col. 3, lines 50 - 55 and 60 - 65); (b) system controller 102 sending

the page wirelessly to the intended PSU 106 (i.e., "pager") via transmitter/receiver 103 (see Fig.

1 and Col. 5, lines 11 - 16); (c) system controller 102 determining if a predetermined time limit

for a response, such as an acknowledgment (ACK) or a non-acknowledgment (NACK), from

PSU 106 has been exceeded (see Fig. 4, step 416); (d) system controller 102 converting the

outbound message received from a message input device to a page message (see Col. 3, lines 60

- 65 and Col. 5, lines 11 - 16); and (e) processing system 204 of system controller 102 storing the

page message when the time limit for a response and the number of retransmissions have been

exceeded and (f) notifying PSU 106 via a second message (or activating a message-waiting

indicator) that a first message is being stored (see Fig. 4, steps 416, 430, and 424; and Col. 10,

lines 14 - 25 and 46 - 55). Per Gorday, PSU 106 is one of several types of devices, including two-

way pagers (see Col. 5, lines 34 - 35). Gorday also imparts that when the intended PSU 106

receives an outbound message transmitted by system controller 102, a user (or "pagee") can use

PSU 106 to generate and transmit an inbound response back to system controller 102. System

controller 102's message handler function identifies the inbound response as having been

generated by the user specifically in response to the outbound message and generates another message that is sent to the originator (i.e., "pagor") of the outbound message to notify the originator that the outbound message has been acknowledged and responded to by PSU 106. (See Col. 6, lines 35 – 52.) In order for a user to respond to the originator's outbound message via PSU 106, system controller 102 must store information relating to the originator's communication mode that can be used to send a response to the originator via system controller 102. Though Gorday discloses that alternate means of delivery, such as voice mail or email, can be used when a page is undeliverable (see Col. 4, lines 53 - 55, is silent on the steps of (1) storing the first message in a communication agnostic format and (2) storing information relating to a plurality of communication modes for the pagor that the pagee can use when returning the page.

In an analogous art, LaPorta's method for sending a page to a recipient (or "pagee") comprises the steps of: (a) two-way message network 14 receiving a page from pager 50a, which is at a first location (see Fig. 3 and Col. 5, lines 53 – 62); (b) two-way message network 14 sending a page via air interface 57a to pager 58, which is at a second location (see Col. 5, lines 53 – 62); and (c) user agent 50 expanding or converting the page into a full message prior to sending the page (see Col. 6, lines 3 – 10). LaPorta also teaches in Figs. 7 and 8 that when a subscriber S 200 sends a message to recipients R1 202, R2 204, and R3 206 via batch server 208, batch server 208 forwards the message to messaging server 210, which contacts the user agent of subscriber 200 (i.e., UA-S 212) (see Col. 14, lines 41 – 62). Messaging server 210 contacts the user agents of the message recipients to determine the location of their corresponding messaging devices, the format in which they wish to received the message, and their status (see Col. 14, lines 60 – 67 and Col. 15, lines 1 – 12). The user agent of recipient R3 (UA-R3) responds

that its pager is off and that the message should be forwarded to message storage server 224 (see Col. 15, lines 15 - 16). Message storage server 224 (d) stores the message, and UA-R3 (e) sends a retrieval ID, thereby activating a message-waiting indicator to R3, when R3 powers on (see Col. 15, lines 44 - 51). It is understood that message storage server 224 stores messages in a communication mode agnostic format because distribution server 116 is responsible for delivering messages to their final destination in the proper format by executing a direct paging algorithm or by routing the messages to a translator prior to transmission (see Col. 11, lines 28 - 35). LaPorta further teaches the step of (f) a sender's user agent storing information relating to format and filtering/forwarding criteria (or communication mode) for the page recipients to use when returning the page (see Col. 6, lines 18 - 25; Col. 7, lines 18 - 40; Col. 8, lines 17 - 18; Col. 11, lines 28 - 42; and Col. 16, lines 5 - 30). Per LaPorta, the originator's message includes an array of reply-to addresses (see Col. 14, lines 41 - 46). In light that a subscriber 40's user agent is able to forward messages as specified by the subscriber and that a subscriber can have a plurality of reply-to addresses, the examiner interprets that the user agent is able to store a plurality of communication modes for a subscriber. Consequently, LaPorta teaches the step of storing information relating to a plurality of communication modes for the sender that the recipient can use when returning the page.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because storing an undeliverable message in a communication mode agnostic supports multicasting without the user having to specify the communication mode and enables a user to send a message to other message devices other than pagers (see LaPorta, Col. 2, lines 58 - 65; Col. 5, lines 53 - 62; and Col. 16, lines 47 - 49). In addition, storing a plurality an originator's communication modes can

be used when a user responds to an originator's message improves the likelihood of the originator receiving the responses, thus improving radio communication system 100's performance.

Regarding claim 2, Gorday's system controller 102 includes an outbound message memory 208 for storing pending and undeliverable messages for PSUs 106 (see Fig. 2; Col. 5, lines 60 – 63; Col. 6, lines 24 – 30; and Col. 10, lines 14 – 20).

Regarding claims 3 and 11, as described above in Claims 1 and 10, Gorday's radio communication system 100 enables PSUs 106 to receive messages from telephones, facsimile machines, and messaging terminals, which are devices other than pagers. This is accomplished by Gorday's system controller 102, which (1) receives messages from telephones, facsimile machines, and messaging terminals, (2) encodes the outbound messages intended for PCU 106, (3) stores a queue of the encoded outbound messages in message memory 208, (4) transmits the outbound messages to PSUs 106, and (5) stores the undeliverable outbound messages in message memory 208 (see Fig. 4, steps 408 and 424; Col. 5, lines 11 – 16; Col. 6, lines 24 – 30; and Col. 10, lines 14 – 25 and 46 – 52). Consequently, Gorday's system controller 102 and transmitter/receiver 103 are understood to form a unified messaging system.

Regarding Claims 5 and 13, Gorday omits teaching the step of system controller 102 receiving from a page sender (i.e., the "originator" or "pagor") at least one of a plurality of predetermined messages that is to be sent to an intended PSU 106.

Per LaPorta, two-way wireless messaging system 10 supports various types of messages, such as pre-canned or predetermined messages (see Col. 13, lines 55 – 67 and Col. 14, lines 1 – 20). Referring to Figs. 7 and 8, LaPorta teaches a sender S 200 sending message PG2BS-NEW, which is one of a plurality of pre-canned messages since user agent UA-S 212 performs the

message expansion function prior to forwarding the message messaging server 210 (see Col. 14, lines 60 – 65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because the step of transmitting at least one of a plurality of pre-canned messages enables the sender (i.e., "pagor") to send messages with limited input, thereby making message generation easy and practical, especially when the messaging device has little or no input means (see LaPorta, Col. 13, lines 47 – 52).

Regarding claims 9, 17, and 21, Gorday's processing system 204, as shown in Fig. 2, includes a conventional computer system 212 and mass storage media 214, wherein the functions of processing system 204 are executed by computer system 212 and controlled by a set of program instructions stored in mass storage media 214 (see Col. 7, lines 2 – 14 and 22 – 30).

Regarding claim 19, as discussed in claim 6, in order for a user (i.e., "pagee") to respond to an originator's (i.e., "pagor") outbound message via PSU 106, system controller 102 must store information relating to the originator's communication mode that can be used by PSU 106 to send a response to the originator. Consequently, Gorday's method further includes the steps of: (a) system controller 102 (i.e., "the unified messaging system") receiving PSU 106's response to a received outbound message; (b) system controller 102's message handler function identifying the inbound response as having been generated by the user specifically in response to the outbound message and generating another message to be sent to the originator for notifying the originator that the outbound message has been acknowledged and responded to by PSU 106; and (c) system controller 102's message handler function retrieving the originator's

communication mode information from memory and routing the new outbound message according to the retrieved information. (See Col. 6, lines 7 – 16 and 35 – 52.)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (703) 305-4086. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY
16 June 2004

BRIAN ZIMMERMAN
PRIMARY EXAMINER